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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
PENDERGRASS, KYLE M	

ART UNIT	PAPER NUMBER
2624	

DATE MAILED: 03/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/922,869	MAKISHIMA ET AL.	
	Examiner	Art Unit	
	Kyle M Pendergrass	2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-9 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-9 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2 & 4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2 recites the limitation "said processing unit" in page 29, line 20. There is insufficient antecedent basis for this limitation in the claim. Examiner suggests changing it to "said data processing unit" so it remains consistent with the claimed invention.

Regarding claim 4, page 30, line 16, the noun following the descriptive element "...a print" is missing. It is unclear as to what the user is authorized to acquire.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-5 & 7-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Tanaka (US 6 519 048).

Regarding claim 1, **Tanaka** teaches a print system (fig 1) comprising:

an input unit (*fig 1, numeral 100*) for inputting a contact destination to be contacted at end of printing *(column 7:lines 49-53, client 100 inputs the print job to the printer, wherein, column 7:lines 42-45, the print job sent by the client contains the address of the contact destination);*

a printer (fig 1, numeral 110) for printing an image on a visible recording medium (column 6:lines 38-40);

a first determination unit *(fig 1, numeral 105)* for determining whether printing by said printer has ended *(column 6:line 66 – column 7:line 17, notice data generator 105 determines the status information of the job which results in knowing whether the job has succeeded or failed, i.e. whether printing has ended)*;

and a transmitting unit (fig 1, numeral 108) , which is responsive to a determination by said determination unit that printing has ended, for transmitting data indicating that printing has ended to a data processing unit, which is specified by the contact destination that has been input by said input unit, via a communication channel (column 7:lines 38-48, notice address manager 108 receives the notification response from notice data generator 105 and transmits the notice to the addressed contact destination which was input by client 100 as part of the job, all of this using the network 109).

Regarding claim 2, **Tanaka** teaches the system according to claim 1, wherein:

said data processing unit is capable of short-distance communication with said print system *(fig 1, network 109 allows client 100 to be capable of short distance communication within print system)*;

said input unit *(fig 1, client 100)* receives identification data *(column 6:line 30, print job)*, which identifies said data processing unit *(column 7:lines 42-45, the print job sent by the client contains the address of the contact destination)*, as the contact destination transmitted from said processing unit by short-distance communication *(column 6:lines 29-37, client 100 receives print job issuance input from user)*;

and the transmitting unit transmits the data indicating that printing has ended to said data processing unit, which is identified by the identification data, by short-distance communication *(column 7:lines 38-48, notice address manager 108 receives the notification response from notice data generator 105 and transmits the notice to the addressed contact destination which was input by client 100 as part of the job, all of this using the network 109)*.

Regarding claim 3, **Tanaka** teaches the system according to claim 2, further comprising:

an image data receiving unit *(fig 1, network interface IF 101)* for receiving image data transmitted from said data processing unit by short-distance communication *(column 6:lines 38-49 printer 110 with network interface 101 receives print job)*;

wherein said printer *(fig 1, printer 110)* records an image represented by the image data, which has been received by said image-data receiving unit, on a visible recording medium *(column 6:lines 38-65, printer prints data)*.

Regarding claim 4, **Tanaka** teaches the system according to claim 3, further comprising:

a request data receiving unit for receiving data indicating a print extraction request transmitted from said data processing unit by short-distance communication *(column 11:lines 45-54, user name and*

password are input as a print extraction request which inherently requires a request data receiving unit for receiving the user name and password);

a second determination unit for determining, in accordance with receipt of the print extraction request data by said request data receiving unit, whether the data processing unit that transmitted the print extraction request data is that of a user authorized to acquire a print *(column 11:lines 36-54, only when the user name and password are input will the print extraction request be authorized. The second determination unit is inherently required in the print system in order to authorize acquisition of a print request. Since the user name and password are designated in the email and are used as the print extraction request, the second determination unit ensures the print extraction request data is that of a user authorized. See column 11:lines 33-35 where the system taught by* ***Tanaka*** *provides advantage such that the print result can only be viewed by only the user indicated by the email on the print job)*;

and a printer control unit *(column 11:line 30, communication server)* for ejecting a visible recording medium, on which printing has been performed by said printer, in response to a determination by said second determination unit that the user is authorized *(column 11:lines 45-54, communication server promotes input of a user name and password, wherein the input from the user is used to authorize releasing the result of the print job)*.

Regarding claim 5, **Tanaka** teaches a data processing unit *(*fig 1, numeral 100*)* that is capable of short-distance communication with a print system *(fig 1, network 109 allows client 100 to be capable of short distance communication within print system)*, comprising:

a transmitting unit for transmitting identification data, which is for identifying the data processing unit, by short-distance communication to said print system as a contact destination to be contacted at end of printing *(column 7:lines 49-53, client 100 inputs the print job to the printer, wherein, column 7:lines 42-45, the print job sent by the client contains the address of the contact destination. This inherently requires a transmitting unit to transmit the contact destination);*

a receiving unit for receiving data transmitted by short-distance communication from said print system indicating that printing has ended *(column 7:lines 38-48, notice address manager 108 receives the notification response from notice data generator 105 and transmits the notice to the addressed contact destination which was input by client 100 as part of the job, all of this using the network 109. This inherently requires a receiving unit that receives the notice)*;

and a notification unit for giving notification of end of printing in response to receipt of printing-end data by said receiving unit *(column 7:lines 38-48, in the teachings of* ***Tanaka*** *a notice message is received by the host computer 100 and then displayed to the user. The notification unit is inherently included during the display of the notice to the user on the client computer 100)*.

Claims 7-8 recite identical features as claims 1& 5, respectively, except claims 7-8 are method claims. Thus, arguments similar to that presented above for claims 1& 5 are equally applicable to claims 7-8.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 6 & 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morgan et al. (US 5 697 761) & Lahey et al. (US 5 999 945) & Tanaka (US 6 519 048).

Regarding claim 6, **Morgan et al.** teach a print system comprising:

an identification-code input unit for inputting the identification code *(column 8:lines 39-41, ID code is input)*;

a holding mechanism *(column 5:lines 53-55, fig 1, multi-bin mail box unit))* for holding, within the print system, visible recording media on which printing has been performed by said printer *(column 6:lines 39-43, user print jobs are stored in mailbox bin(s) 11)*;

and an ejection unit *(column 8:line 33, mailbox unit bin 11)* for ejecting, from said holding mechanism to the outside of said print system, the visible recording medium on which the input identification code has been recorded from among the visible recording media being held by said holding mechanism *(column 8:lines 29-41, after password input has been received and print job extraction has been authorized, bin 11 is unlocked and print job is ejected)*.

Morgan et al. do not teach a system further comprising: a printer for printing an image and an identification code, which is for identifying the owner of the image, on a visible recording medium,

However, **Lahey et al.** teach a printer for printing an image and an identification code, which is for identifying the owner of the image, on a visible recording medium *(column 7:lines 33-37, a cover sheet is printed for print/copy job that, column 5:lines 54-58, identifies the owner)*.

Accordingly, it would have been obvious to one skilled in the art at the time of the invention to have used the cover sheet taught by **Lahey et al**. in the print and mailbox system taught by **Morgan et al**. because it further distguishes the print job.

Niether **Morgan et al.** nor **Lahey et al**. teach an identification-code notification unit for giving notification of the identification code printed on the visible recording medium by said printer.

However, **Tanaka** teach an identification-code notification unit for giving notification of the identification code printed on the visible recording medium by said printer *(column 11:lines 19-54, a notification is given that passes the print job user and password information to the user authorized to access a print result, which inherently requires a notification unit)*.

Accordingly, it would have been obvious to one skilled in the art at the time of the invention to have used the notification unit taught by **Tanaka** in the system taught by **Morgan et al. & Lahey et al**.

because it provides a notice function to pass along an email with job status information, along with user information according to the print result and a password authorizing the user to access the print result.

Claim 9 recites identical features as claim 6 except claim 9 is a method claim. Thus, arguments similar to that presented above for claim 6 are equally applicable to claim 9.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kyle Pendergrass whose telephone number is **(571) 272-7438**. The examiner can normally be reached on Monday-Friday 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, King Poon can be reached on **(571) 272-7440**.

KING Y. POON
PRIMARY EXAMINER